

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed January 21, 2009. The Examiner is thanked for the thorough examination of the present application. Upon entry of this response, claims 1-4, 6-14, 29-42 and 57 are pending in the present application. Applicants respectfully request consideration of the following remarks contained herein. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants have canceled claim 3, thereby rendering the objection of claim 3 moot.

II. Response to Claim Rejections Under 35 U.S.C. § 101

Claims 1-4, 6, 7, 13, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. As indicated above, Applicants have amended claim 1. No new matter is added. Specifically, claim 1 (as amended) now recites:

1. A method for reducing interference due to handshake tones in the frequency domain in a communication system, the method comprising the steps of:
 - receiving an input signal $X_t[q]$ in the frequency domain at bin q and time-symbol t , wherein the input signal has a short correlation time component and a long correlation time component;
 - attaining near zero correlation for the short correlation time component, wherein attaining near zero correlation for the short correlation time component comprises generating a delayed signal by delaying the input signal by a time-symbol value N , wherein N is an integer such that the generated delayed signal is $X_{t-N}[q]$;
 - generating a prediction signal with long correlation properties

based at least in part on the delayed signal;
comparing the input signal and the prediction signal; and
reducing a variance between the input signal and the
prediction signal
**wherein the steps are performed in a transceiver within
the communication system.**

(Emphasis added). In view of the amendments, Applicants believe that claim 1 is now directed to statutory subject matter. The recitation of a transceiver within a communication system in claim 1 clearly ties claim 1 to a proper statutory class of invention (e.g., a machine). As such, claim 1 clearly satisfies the machine-or-transformation test of *In re Bilski*. Applicants respectfully request that the rejection of claims 1-4, 6, 7, 13, and 14 be withdrawn.

III. Response to Claim Rejections Under 35 U.S.C. § 102

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102.

Claim 57 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Ghosh* (U.S. Pat. No. 5,777,692). Applicants respectfully traverse the rejection. Applicants respectfully submit that independent claim 57 patently defines over *Ghosh* for at least the reason that *Ghosh* fails to disclose, teach, or suggest each feature in claim 57. Applicants have amended claim 57 such that claim 57 is now directed to "A system for reducing interference due to handshake tones in the frequency domain." While Applicants appreciate the fact that preambles are typically not given any weight in

determining patentability, in some circumstances (as in the present circumstance), the preambles are to be given patentable weight. Specifically, proper claim construction also includes the determination of whether language included in the preamble of the claim is to be given the same weight as the language that makes up the body of the claim. In this regard, the preamble may be limiting "when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). Here, the Examiner apparently agrees. In addressing claim 1 ("A method for reducing interference due to handshake tones in the frequency domain"), the Examiner acknowledges that *Ghosh* fails to disclose a method for reducing interference caused by handshake tones. (Office Action, page 6). Further, as discussed in depth below, the secondary reference (*Duvaut*) is disqualified as prior art under 35 U.S.C. § 103(c). Claim 57 is thus patentable over the cited art of record. In view of the amendment to claim 57, Applicants respectfully request that the §102 rejection be withdrawn.

IV. Response to Claim Rejections Under 35 U.S.C. § 103

Claims 1-4, 6-9, 13, 14, 29-37, 41, and 42 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Ghosh* in view of *Duvaut et al.* (U.S. Pub. No. 2004/0141550, hereinafter "*Duvaut*"). Claims 10-12 and 38-40 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Ghosh* in view of *Duvaut* further in view of *Bergmans* (U.S. Patent No. 4,905,254). Applicants traverse the rejections.

Statement under 35 U.S.C. 103(c)

Application Serial No. 10/672,079 and the cited *Duvaut* reference (U.S. Pub. No. 2004/0141550) were, at the time the invention of Application No. 10/672,079 was made, owned by Globespan Virata, Inc. In this regard, Applicants respectfully submit that the *Duvaut* reference and the present application were commonly-owned or under an obligation to be assigned to the same entity. According to MPEP 706.02(I)(2), the foregoing statement is sufficient to establish this fact.

Applicants respectfully submit that the *Duvaut* reference is therefore disqualified as prior art under 35 U.S.C. § 103(c) because the *Duvaut* reference qualifies as prior art under one or more sections (e), (f) and (g) of Section 102, and the present application and the *Duvaut* reference were commonly owned or under an obligation of assignment to the same person at the time the invention was made. The Manual of Patent Examining Procedure (MPEP) 706.02(I)(2) provides in pertinent part:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

With the removal of *Duvaut* (U.S. Pub. No. 2004/0141550) as a reference under 35 U.S.C 103(c), the above rejection of the claims above is considered moot.

Based on the foregoing, Applicants respectfully submit that because all of the obviousness rejections are premised on the *Duvaut* reference and because the *Duvaut* reference is disqualified as prior art under 35 U.S.C. § 103(c), the obviousness rejections have been overcome and should be withdrawn.

CONCLUSION

Applicants respectfully submit that all pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 50-0835.

Respectfully submitted,

/Jeffrey Hsu/

Jeffrey C. Hsu
Reg. No. 63,063

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.
600 Galleria Parkway SE
Suite 1500
Atlanta, Georgia 30339
(770) 933-9500